

Remarks

In response to the concerns that the Examiner has raised in the aforementioned Office Action, these items are thoroughly addressed below in the order presented in the Office Action. Applicants strenuously traverse the rejections of claims 1-6 for all of the reasons cited below. Allowance of all pending claims 1-6 is respectfully requested.

Preliminarily, however, a key fact should be fully and completely understood by the Examiner. In the method described in the published patent application in the name of Chen et al. having a filing date of July 17, 2001 and a publication date of January 23, 2003, suspended applications are terminated. All of the present Applicants' claims recite suspension but not termination. The present Applicants are extremely well positioned to assert this position since, not only are the two applications assigned to the same assignee, but at least one of the inventors herein (Dawn Moyer) has worked closely with Winston Chen, the first named inventor in the published application cited by the Examiner. The prior filing of the invention of Chen et al. was a mere happenstance of the workloads of the prosecutorial burdens of disparate legal representatives.

In paragraph #1 the Examiner has raised an issue with respect to language in the prior submitted affidavit under Rule 1.131. In this regard, it is first noted that this language appears in the affidavit as proof, not only of conception, but of a complete reduction to practice of the claimed invention prior to the filing date of the cited published patent application. Clearly, any date in the year 2000 is prior to July 17, 2001. The assertion that the subject invention was present in code that was made generally available supports the assertion that a fully completed reduction to practice had occurred. It is not the practice of the assignee to ship code which has not been fully tested and vetted. The prior submitted affidavit under Rule 1.131 fully supports this assertion. Accordingly, this date was included as evidence of a completed reduction to practice prior to July 17, 2001.

With respect to the Examiner's unsupported assertion of public use or on sale issues, it is further noted that the present Applicants' filing date of October 25, 2001 is also fully consistent with the requirements of 35 U.S.C. § 102(b). This statute grants unto inventors the unfettered right to sell and use their inventions for one year prior to the filing of a U. S.

patent application. So that the Examiner fully comprehends the sequence of events and their import, it is noted that the term “general availability” is for all practical and legal purposes exactly equivalent to “on sale.” For products which are generally available, customers can submit order requests with an expectation of product delivery by various means. A general availability date any time between October 25, 2000 and December 31, 2000 is fully and absolutely consistent with the requirements of 35 U.S.C. § 102(b) and with Applicants’ assertion of reduction to practice well before the filing date of the cited document (Chen et al.). Applicants implied assertion that the subject general availability date occurred during the time period between October 25, 2000 and December 31, 2000 is uncontroverted. Furthermore, Applicant’s recitation of a date before the end of the year 2000 in the proffered affidavit was merely a reference to what was to the affiant a point in time that was well-defined and known to be prior to the filing date of the cited application of Chen et al .

There is nothing contained within the affidavit taken together with the prosecution history herein that would in anyway indicate that there is either an on-sale or public use issue with respect to the claimed invention. The facts of the present case are absolutely 100% consistent with a timely patent application filing that is in full and complete conformance with 35 U.S.C. § 102(b). Accordingly, the Examiner is without standing in asserting, suggesting or alleging anything to the contrary. The requirements set forth in 37 CFR § 105 mandate that the request for information be reasonably necessary. The Examiner’s request is not a reasonable one since all facts known to the Examiner at the time of the request were consistent with the lack of both public use and on-sale bars. The Examiner’s request is also not necessary for the same reason. Nonetheless, in spite of the fact that the Examiner is without cause or basis in asserting his request under 37 CFR § 105, Applicants do hereby indicate that the general availability date in question was October 27, 2000.

Furthermore, it is noted that the Examiner’s request “for **any** information concerning the public use and/or sale of the claimed invention” [emphasis added herein] is both vague and indefinite. Applicants’ legal representative is unable to glean from this request the specific nature of the information that the Examiner seeks other than perhaps the actual date of general availability which has already been provided above.

Attention is now directed to the issues raised by the Examiner in paragraph #2 of the aforementioned Office Action. Here the Examiner's issue appears to be the fact that the affidavit previously submitted was not signed by all of the inventors. There is no requirement in the statutes or the regulations for an affidavit under Rule 1.131 for such an affidavit to be signed by all of the inventors. In the case of a patent under Reexamination it is not even a requirement that these affidavits be signed by any inventor, much less all of the inventors. In the case at hand, one of the reasons for not including all of the inventors as signatories to the affidavit is that one of the inventors (Nick Rash) is now deceased. While 37 § CFR 1.131 makes reference to 37 CFR § 1.42 relating to oaths in the case of deceased inventors, the fair reading of these two regulations is that together they make no sense whatsoever. An affidavit under 37 CFR § 1.131 is meant to attest to facts. A decedent's representative is, however, in no way competent or knowledgeable in the matters that are of concern in an affidavit under 37 CFR § 1.131. There is no reasonable way to read into the combination of 37 CFR § 1.131 and 37 CFR § 1.42 a requirement that a decedent's representative be required to sign such an affidavit. Such representatives typically have no information pertaining to the facts that would be recited, particularly those that relate to conception and reduction to practice. Such representatives might, for example, be a distant relative who has had no contact with the decedent for decades. Clearly, in such cases it is obvious that not all of the inventors should be required to sign a Rule 1.131 affidavit. Accordingly, the affidavit submitted herewith is signed only by current inventors who are still living.

Furthermore, while Rule 1.131 refers to "the inventor," the language of the regulation makes no reference to all of the inventors or even that any inventor actually be a signatory of the affidavit. The regulation refers only to having the inventor submit an appropriate affidavit. There is no requirement in the regulation that all of the inventors sign a Rule 1.131 affidavit. Inventors regularly submit responses to Office Actions with the only signature being provided being the signature of their attorneys. Accordingly, it seems clear that the recitation and usage of the word "submit" in the regulation cannot be interpreted as a requirement that the affidavit actually be signed by the inventor.

Furthermore, the language in MPEP § 704.5(I) is not mandatory. The language is permissive in that it uses the word “may.” Additionally, the Examiner’s reliance on the MPEP does not carry with it the weight of either regulation or statute. It exists merely as an internal working guide for patent examiners. It is a document that may bind an Examiner in his or her operations but it is not in any way effective to change interpretations of statutory and regulatory language.

Facts and reality also add to the fairness and accuracy of this interpretation of the regulation with respect to the meaning of the word “submit.” For example, in the instance in which a non-inventor working under the direction and control of an inventor is the one who actually performs the tests suggested by an inventor, it is that person who is best able to attest to a successful test result. The public is clearly best served when the facts presented in a Rule 1.131 affidavit are most accurate. In the situation cited, those facts would be best presented and laid out by a non-inventor. Thus, as a matter of public policy it ought not be the case that all Rule 1.131 affiants must, of necessity, be inventors. Accordingly, Applicants assert that the prior submitted affidavit is in full conformance with the signature requirements of 37 CFR § 1.131.

Attention is next directed to the concerns that the Examiner has raised in paragraph #3 of the subject Office Action. In this regard it is noted that claims 1 and 2 are independent claims. Claims 3-6 are dependent claims. The Examiner is incorrect in asserting that an affidavit under 37 CFR § 1.131 must be directed to every claim in an application. In this regard the Examiner is directed to the requirements set forth for the corps. of Examiners in MPEP § 715.02. The Examiner is also directed to the cases of *In re Tanczyn*, 347 F.2d 830, 146 USPQ 298 (CCPA 1965) and *In re Stryker*, 435 F.2d 1340, 168 USPQ 372 (CCPA 1971). Furthermore, the following quotation from MPEP § 715.02 is also instructive in establishing the fact that not every claim needs to be the subject of a Rule 1.131 affidavit:

“A reference or activity applied against generic claims may (in most cases) be antedated as to such claims by an affidavit or declaration under 37 CFR 1.131 showing completion of the invention of only a single species, within the genus, prior to the effective date of the reference.....”

The following language from is also instructive:

“It is not necessary for the affidavit evidence to show that the applicant viewed his or her invention as encompassing more than the species actually made. The test is whether the facts set out in the affidavit are such as would persuade one skilled in the art that the applicant possessed so much of the invention as is shown in the reference or activity. *In re Schaub*, 537 F.2d 509, 190 USPQ 324 (CCPA 1976).” [Emphasis added herein.]

In the present case the species actually made is that set forth in claim 1 which is fully supported as having been reduced to practice by the inventors as set forth in the prior submitted affidavit. Accordingly, following the Examiner’s own set of MPEP guidelines requires that a Rule 1.131 affidavit be considered as eliminating the effect of a reference as long as the affidavit sets out facts illustrating that the Applicant possessed so much of the invention as is found in the reference and is being used by the Examiner as negating patentability. As stated at the very beginning of the Remarks section of this response, Applicants and Chen et al. differ in that, contrary to what the Examiner has asserted, Applicants’ claimed invention does not terminate suspended applications. However, solely for the sake of argument, even if the patent application of Chen et al. could properly be read to conclude that this were the case, the previously submitted affidavit clearly indicates that this concept was possessed by the present inventors well before the priority date of the cited document.

The Examiner is also ignoring other well established case law regarding the use of Rule 1.131 affidavits. In the case of *In re Stempel*, 241 F.2d 755, 113 USPQ 77 (CCPA 1977) it was stated:

“We are convinced that under the law all the applicant can be required to show is priority with respect to so much of the claimed invention as the references [sic] happens to show. When he has done that he has disposed of the references....”

In the present case, the submitted document should be particularly considered for those recitations found on page 26 thereof. Item #2.2.3.8 is of particular relevance to the present prosecution since it supports Applicants’ assertion that previously suspended windows (that is, “applications” in the current context) are restarted. This clearly refers to a

situation in which running applications are suspended rather than being terminated. The Examiner will note that the date on the submitted document is well before the priority date of the cited patent. This factual scenario fits well within the reasoning of the courts in *In re Stempel*. Of relevance here is that the cited patent application does not claim “suspend but do not terminate” operations. All of Applicants’ claims contain this recitation. This concept has been shown to be possessed by the present inventors well before the priority date of the cited patent application. Applicants have also demonstrated that their code had been tested and verified and that a completed reduction to practice occurred well before the subject priority date (July 17, 2001). Accordingly, settled case law requires the removal of the patent application to Chen et al. as a reference in the prosecution of the present patent application. Contrary to the Examiner’s assertion there is no need to provide a claim by claim, element by element comparison of Applicants’ claims versus the previously provided design document. However, one is provided at the end of this response.

Attention is now directed to the comments of the Examiner as set forth in his paragraph #4. The Examiner also appears to be either ignoring or failing to appreciate the nature of the evidence set forth in the prior submitted Rule 1.131 affidavit. The Examiner is correct in his belief that the document submitted is and was a design document which was included as evidence of conception. However, this document includes and describes actual code that was tested by the group within IBM referred to as Functional Verification Test (FVT). This document thus stands not only for evidence of conception but as an approved document describing code and concepts that had been tested and found to pass. The fact that the document stands as having been approved by an independent test group raises its importance from that of a mere proof of conception to a proof that the concept was tested and found to work. It is thus evidence also, **as an independently approved document**, of a reduction to practice. Accordingly, Applicants have added a paragraph #17 which seeks to address some of the concerns raised by the Examiner. Of particular note is the fact that the feature number matches the feature number ascribed elsewhere in the affidavit to this invention, namely #47587. Also of note is the fact that the subject record contents indicate that the testing was “closed.” This means that all tests of the subject code were completed satisfactorily, clearly demonstrating a reduction to practice of the claimed invention, all of whose aspects are described in the document submitted. In this regard, the Examiner’s

attention is specifically directed to the portion of the present document below which more particularly matches claim language and steps to the subject approved design document.

Solely for the benefit and understanding of the Examiner, it should be fully appreciated that in the design of program products which are to be sold to the public by the assignee of the present invention, there are very structured processes that exist to insure that only quality products are provided. This includes the fact that once a designer of a new feature has produced a structured a document such as the one accompanying the submitted affidavit, even though a designer may have done some testing, the most relevant testing is done by an independent entity within the assignee's business. In the present situation this activity is carried out by the FVT group. This group designs tests and reports back to the relevant parties the results of the tests. This group will also, from time to time, issue "defect" (problem) notices against the code. The problem is corrected and returned to test until a satisfactory level of achievement is reached. Clearly, as with most endeavors in the production of code, it is an iterative process. It ends with approval by the FVT group.

Accordingly, the Examiner should fully appreciate that invention testing is an activity which is not left to the inventors/designers of the code alone. The inventors of software code are typically not in the best position to be able to attest to detailed facts concerning the testing operations performed. However, the inventors do receive feedback from the FVT group relevant to problems, as noted above, and also with respect to test completion. The FVT group uses the design document to construct testing regimens independently of the designers as a mechanism to insure a quality product under the theory that two sets of independent reviewers are better than one.

In the present case, the inventors received this approval as noted in the prior submitted affidavit. Accordingly, prior to the filing date of the subject application, the inventors had been provided with the full and proper notice that all tests were successful. It is within this backdrop of facts that the prior affidavit was submitted. Prior to the filing of the present invention the inventors had conceived of all the steps recited in the present claim set and fully believed that all tests were successful and that there was no doubt but that the invention had been reduced to practice since the FVT group had fully supported release of

the code as a product. The submitted affidavit should be considered against this background to fully appreciate its contents.

With respect to the specific art based rejection of Applicants claims as set forth in paragraphs 5-13 of the aforementioned Office Action, Applicants repeat the assertions made in the response submitted on August 22, 2005.

MATCH OF CLAIMS TO THE DESIGN DOCUMENT

CLAIM 1

Step #1

The detection of a potential error condition is identified via error class masks that correspond to each specific error interrupt register on the adapter. These masks classify which bits should be treated as possible recoverable critical adapter errors. The FLIH (first level interrupt handler) and SLIH (second level interrupt handler) functions **cadd_intr** and **cadd_intr_offlvl** in file **cadd_intr.c** respectively on the affected node classifies and responds to all hardware error interrupts generated by the adapter. Eventually this classification and hardware error registers get passed to the FSD (Fault Service daemon) for further actions.

See pages 18 and 19 of the previously cited document.

Step #2

Communications are suspended from within the node via suspension of all existing open windows and rejecting any new window opens on the adapter experiencing the critical adapter error condition. A **CSS_SUSPEND_WINDOW** event is posted to all registered window owners. HAL and IP will leave the windows open, drop packets and return successfully on reads and writes. There is no explicit notification to the protocols (APIs) that the window resources are no longer available. This notification would cause the protocols to terminate the running applications 100% of the time. The FLIH function **cadd_intr** in file **cadd_intr.c** uses the **cadd_suspend_windows** function in file **cadd_intr.c** to suspend communications within the node without termination of the applications that are running. HAL uses function **_col_suspend_win** in file **_col.c** and IP uses function **ifcl_suspend_window** in file **ifcl_cfg.c** to take appropriate actions on the posted suspend event from the FLIH. *See page 29 of the previously cited document.*

Step #3

The SLIH for initial critical adapter errors (Kill interface active) or the FSD for escalated transient to critical adapter errors on the affected node resets the affected adapter to clear up any possible hang conditions. Resetting the adapter results in disabling the link (link no

longer timed) which will in turn causes link sync failures to be raised to the FSD switch recovery code running on the Primary node (FSD central point of control). Switch recovery will suspend thresholding of lync sync errors for 10 seconds. After 10 seconds switch recovery will continue to count lync syncs within a specific time period for thresholding purposes. If the recovery actions on the affected node do not re-enable the link within the 10 seconds, the FSD switch recovery on the primary node will threshold and fence the affected adapter off the switch. This fence will release all window resources on the affected adapter which will result in the termination of running applications using these resources. The SLIH disables communications between the affected adapter and the primary FSD node via function **cadd_adapter_reset** in file **reset.c**. The FSD switch recovery suspends thresholding and fences the adapter upon meeting the lync sync threshold via function **CS_Switch_error_recovery** in file **CSrecovery.c**. Resources are released via existing FSD base function **cadd_adapter_resource_release** in file **cadd_auth.c**. *See page 27 of the previously cited document.*

Step #4

The FSD adapter function **fs_daemon_fsm_adapter_thread_main** in file **fsd_fsm_adapt.c** will start the adapter which re-enables the link via function **cadd_adapter_start** in file **start.c**. *See page 25 of the previously cited document.*

Step #5

The FSD will resume communication on the affected adapter after successful recovery actions by resuming the suspended windows on the adapter via **cadd_resume_windows** in file **cadd_auth.c**. *See page 27 of the previously cited document.*

CLAIM 2

Step #1

See Claim 1, step 1.

Step #2

See Claim 1, step 2.

Step #3

See Claim 1, step 3.

Step #4

See Claim 1, step 4.

Step #5

If FSD recovery actions are unsuccessful for any reason (adapter port not enabled in time or any **ioclt** fails) the resources will be released via existing FSD base function **cadd_adapter_resource_release** in file **cadd_auth.c**. This will result in the termination of the running application. *See page 27 of the previously cited document.*

Step #6

See Claim 1, steps 4 and 5.

CLAIM 3

Step #1

See Claim 1, step 2.

CLAIM 4

Step #1

See Claim 1, step 2.

CLAIM 5

Step #1

See Claim 1, step 3.


CLAIM 6

Step #1

The FSD will take an early snap to collect error data cleared via reset prior to resetting the adapter for escalated critical adapter errors (kill interface not active). The FSD will always take a final snap when recovery actions have completed. FSD invokes snaps via shell script **css.snap** using appropriate flags. *See page 48 of the previously cited document.*

From the above, it should now be appreciated that all of the Examiner's concerns have been addressed. Accordingly, it is respectfully requested that the rejection of Applicants' claims 1-6 be withdrawn. Prompt allowance of these claims is therefore earnestly requested. It is also noted that Applicants' attorney is also available for telephonic communications and is willing to discuss any matters with the Examiner that would forward the present application toward issuance. Should the Examiner wish to discuss this case with Applicants' attorney for this purpose or for any other purpose, please contact Applicants' attorney at the listed number below.

Respectfully submitted,



Lawrence D. Cutter
Attorney for Applicants
Registration No.: 28,501

Dated: January 23, 2006.

HESLIN ROTHENBERG FARLEY & MESITI P.C.
5 Columbia Circle
Albany, New York 12203-5160
Telephone: (518) 452-5600
Facsimile: (518) 452-5579